

group 17: claims 39 and 40, class 514, subclass 2;
group 18: claims 41 and 42, class 514, subclass 44;
group 19: claims 43 and 44, class 514, subclass 2;
group 20: claims 45 and 46, class 514, subclass 44; and
group 21: claims 41 and 42, class 514, subclass 2.

Election with Traverse

Applicants hereby elect, with traverse, the claims of group 7 and the nucleic acid of SEQ ID NO: 1.

Discussion of Requirement for Restriction

There are two criteria for a proper requirement for restriction between patentably distinct inventions. The inventions must be independent or distinct as claimed and there must be a serious burden on the examiner if restriction were not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

The Office attempts to establish that the groups of claims are directed to distinct inventions under the criteria of M.P.E.P. § 806.05(c)-§ 806.05(i). Yet, as stated in M.P.E.P. § 808.02, even if related inventions are shown to be distinct under such criteria, "the examiner, in order to establish reasons for insisting upon restriction must show by appropriate explanation one of the following: (1) [s]eparate classification thereof...(2) [a] separate status in the art when they are classifiable together...(3) [a] different field of search."

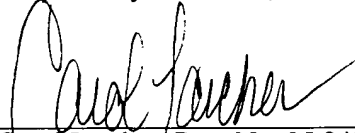
In the case at hand, groups 1-6 are classified together, groups 7-12 are classified together, groups 16, 18 and 20 are classified together, and groups 17, 19 and 21 are classified together. Given the absence of the Office showing "by appropriate explanation" a different field of search when groups are classified together, Applicants submit that groups 7-12, groups 1-6, groups 16, 18 and 20, and groups 17, 19 and 21 could and should be searched together. Therefore, Applicants request that the restriction requirement be withdrawn at least in part, such that groups 7-12 are combined, groups 1-6 are combined, groups 16, 18 and 20 are combined, and groups 17, 19 and 21 are combined for search and examination. At the very least, Applicants request that groups 7-12 be searched and examined together. Furthermore, since SEQ ID NOS: 1, 10, 11 and 15 all relate to human nucleic acids, SEQ ID NOS: 10, 11 and 15 could and should be searched with SEQ ID NO: 1.

In re Appln. of Baumann et al.
Application No. 09/640,582

Conclusion

The application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: January 18, 2002

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CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: January 18, 2002 Ellen H. Mann